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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,160	04/14/2004	Paul E. Carpenter	NTR-001	8171

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EXAMINER	
ALLEN, WILLIAM J	
ART UNIT	**PAPER NUMBER**
3625	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/824,160	CARPENTER ET AL.	
	Examiner	Art Unit	
	William J. Allen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/11/04; 11/22/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 26 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 26, Claims to computer-related inventions that are clearly nonstatutory fall into the same general categories as nonstatutory claims in other arts, namely natural phenomena such as magnetism, and abstract ideas or laws of nature which constitute "descriptive material." Abstract ideas, Warmerdam, 33 F.3d at 1360, 31 USPQ2d at 1759, or the mere manipulation of abstract ideas, Schrader, 22 F.3d at 292-93, 30 USPQ2d at 1457-58, are not patentable. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data. Both types of "descriptive material" are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F.3d at

1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Claim 26 fails to recite in the preamble a computer program that is embodied on a computer-readable medium. The claim is merely directed to a computer program per se. Proper format should resemble the following:

> "A computer readable medium storing a computer program containing instructions thereon for instructing a computer to perform the steps of: ..."

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-5, 7-9, 20-22, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (6,167,383) in view of Silva et al. (US 2001/0034658, herein referred to as Silva).

Regarding claim 1, Henson teaches:

a. providing information from a first vendor to a second vendor about items available from the first vendor that are available for inclusion within items offered by the second vendor to a consumer for purchase at retail as a virtual bundle of items (see at least: Fig. 3A-5); The Examiner notes that products from first vendors such as Intel, Iomega, Microsoft, and the like are bundled with products such as computer towers and monitors from Dell (second vendor);

c. communicating an offer by the second vendor to a consumer for the purchase at retail of a virtual bundle of items from those items available for inclusion within the virtual bundle (see at least: Fig. 6-10, abstract, col. 4 lines 36-52);

d. allowing the consumer to create and purchase at retail a virtual bundle of items from those items available for inclusion within the virtual bundle (see at least: Fig. 1-10,

abstract, col. 4 lines 36-52); The Examiner notes that the customized computer system is a bundle.

Henson teaches all of the above as noted and further teaches a customization web site featuring products from outside manufacturers (see at least: Fig. 1-5). Henson, however, does not expressly teach *b. providing information from the first vendor to the second vendor about an incentive offered by the first vendor to the second vendor based on the virtual bundle of items purchased by the consumer; e. providing information about the virtual bundle of items purchased by the consumer to the first vendor and the second vendor; and f. providing an incentive from the first vendor to the second vendor based on the virtual bundle of items purchased by the consumer.* Silva teaches a system for selling bundles of multiple items through the use of electronic shopping lists (see at least: abstract). Silva further teaches:

b. providing information from the first vendor to the second vendor about an incentive offered by the first vendor to the second vendor based on the virtual bundle of items purchased by the consumer (see at least: abstract, 0003-0004, 0006);

e. providing information about the virtual bundle of items purchased by the consumer to the first vendor and the second vendor (see at least: abstract, 0003-0004, 0017, 0025-0026); *and*

f. providing an incentive from the first vendor to the second vendor based on the virtual bundle of items purchased by the consumer (see at least: abstract, 0003-0004, 0006). The Examiner notes that an affiliate site acts as a referring site for the associate merchant site (i.e. first and second vendors). When a transaction, such as purchasing of

a bundle, is completed the merchant site pays a percentage of the purchase made to the affiliate site, and thereby provides a financial incentive. Additionally, since that percentage is based on the transaction (i.e. purchased bundle), it thereby constitutes information about the transaction (i.e. virtual bundle purchased) and information about the incentive offered to the affiliate site by the merchant site. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Henson to have included *b. providing information from the first vendor to the second vendor about an incentive offered by the first vendor to the second vendor based on the virtual bundle of items purchased by the consumer; e. providing information about the virtual bundle of items purchased by the consumer to the first vendor and the second vendor; and f. providing an incentive from the first vendor to the second vendor based on the virtual bundle of items purchased by the consumer* as taught by Silva in order to provide merchandising that is financially beneficial to the of both the merchant and an affiliate of the merchant (i.e. first and second vendors) by providing an external source of potential customers who are already viewing material directly related to the merchant and an additional source of income to an affiliate of the merchant (see at least: Silva, 0003).

Regarding claims 2-5 and 7-8, Henson teaches:

(2) *wherein the first vendor is the manufacturer of the items available for inclusion within the virtual bundle of items* (see at least: Fig. 3A-5).

(3) *wherein the second vendor is a customer of the manufacturer* (see at least: abstract, Fig. 3A-5).

(4) wherein the items are identified by a unique identification code (see at least: Fig. 3A-5). The Examiner notes the use of product identifiers unique to each products as 'unique identification codes'.

(5) *wherein the items are products, services, or combinations thereof* (see at least: Fig. 3A-5).

(7) wherein the consumer is given an incentive for purchasing the virtual bundle of items (see at least: Fig. 3A-5). The Examiner notes that each component/product provides a description for purchasing that component/product with the bundle (e.g. a larger hard drive provides more storage). Incentive is also provided to purchase a certain system (e.g. the XPS R is built with "performance and reliability in mind"). Furthermore, the ability to lease a bundle provides a financial incentive to the consumer to purchase the bundle.

(8) *wherein the second vendor receives a financial incentive each time a consumer purchases a virtual bundle of items in a single market basket transaction* (see at least: col. 4 lines 36-52, col. 6 lines 39-43, col. 7 lines 39-48, col. 10 lines 7-18). The Examiner notes that by selling the customer configured systems (i.e. the bundled items for purchase), and further by providing items to be added on, the selling vendor receives

a financial incentive by receiving revenue from the sale of the configured system/bundled items. Additionally, add-ons increase the revenue and provide an additional financial incentive to bundle additional items.

Regarding claim 9, Henson teaches all of the above as noted but does not expressly teach *wherein information about the items available from the first vendor for inclusion in a virtual bundle is posted on a server.* Silva teaches *wherein information about the items available from the first vendor for inclusion in a virtual bundle is posted on a server* (see at least: Silva, 0025-0026, Fig. 1 and 4). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Henson to have included *wherein information about the items available from the first vendor for inclusion in a virtual bundle is posted on a server* as taught by Silva in order to provide merchandising that is financially beneficial to the of both the merchant and an affiliate of the merchant (i.e. first and second vendors) by providing an external source of potential customers who are already viewing material directly related to the merchant and an additional source of income to an affiliate of the merchant (see at least: Silva, 0003).

Regarding claim 20, claim 20 closely parallels the limitations of claim1. Claim 26 is rejected under the same rationale.

Regarding claims 21-22, Henson in view of Silva further teaches:

(21) *an interface circuit configured to establish a connection with a remote computer system* (see at least: Fig. 1-10).

(22) *wherein the means for posting information is included within a server on which information about the available items is stored* (see at least: Henson, Fig. 1-2; Silva, 0025-0026, Fig. 1 and 4).

Regarding claim 26, claim 26 closely parallels the limitations of claim1. Claim 26 is rejected under the same rationale.

5. Claims 10-14 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Silva, as applied to claim 1-5 and 7-9 above, and further in view of Andrews (6,285,986).

Regarding claim 10, Henson in view of Silva teach all of the above as noted and further teach *wherein information about the items available from the first vendor for inclusion in a virtual bundle is posted on a server* (see at least: Silva, 0025-0026, Fig. 1 and 4). Henson in view of Silva, however, does not expressly teach establishing an internet connection with the server *for the second vendor to view and select the items available for inclusion within the items offered to a consumer for purchase as a virtual bundle of items*. Andrews teaches an internet connection *for the second vendor to view and select the items available for inclusion within the items offered to a consumer for purchase as a virtual bundle of items* (see at least: abstract, Fig. 3-5a, col. 5 lines 1-50). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Henson in view of Silva to have included *for the second vendor to view and select the items available for inclusion within the items offered to a consumer for purchase as a virtual bundle of items* as taught by Andrews in order to provide a system for automated registration, negotiation, and marketing for combining products and services from one or more vendors together to be sold as a unit to automate the promotion and sale of product groups/bundles (see at least: Andrews, abstract, col. 1 lines 25-29).

Regarding claims 11-13, Henson in view of Silva further teaches:

(11) *wherein the second vendor receives a financial incentive each time a consumer purchases a virtual bundle of items in a single market basket transaction* (see at least: Henson, col. 4 lines 36-52, col. 10 lines 7-18). The Examiner notes that the selling vendor receives the incentive as in claim 8 for each purchase made.

(12) *wherein information about the market basket transaction is collected, stored and transferred for processing and validation* (see at least: Henson, col. 4 line 66-col. 5 line 5, col. 6 lines 31-38 and 44-67, col. 7 lines 36-48).

(13) *wherein the information is processed on a server* (see at least: Henson, Fig. Fig. 1-2; Silva, 0025-0026, Fig. 1 and 4).

Regarding claim 14, Henson in view of Silva teaches all of the above as noted but does not expressly teach *wherein reports comprising information about the virtual bundle of items purchased by the consumer are generated and provided to the first vendor and the second vendor.* Andrews teaches *wherein reports comprising information about the virtual bundle of items purchased by the consumer are generated and provided to the first vendor and the second vendor* (see at least: Fig. 1, 8, abstract, col. 6 lines 35-36, col. 12 line 8-col. 13 line 2). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Henson in view of Silva to have included *wherein the information is processed on a server and wherein reports comprising information about the virtual bundle of items purchased by the consumer are generated and provided to the first vendor and the second vendor* as

taught by Andrews in order to provide a system for automated registration, negotiation, and marketing for combining products and services from one or more vendors together to be sold as a unit to automate the promotion and sale of product groups/bundles (see at least: Andrews, abstract, col. 1 lines 25-29).

Regarding claims 23-24, Henson in view of Silva teaches all of the above and further teaches *providing information from a first vendor to a second vendor about items available from the first vendor that are available for inclusion within items offered by the second vendor to a consumer for purchase at retail as a virtual bundle of items* (see at least: Henson, Fig. 3A-5; Silva, 0025-0026). Henson in view of Silva, however, does not expressly teach *wherein a connection is established to view, select and accept information about the offer from the first vendor where only registered with the server as authorized users are allowed to view, select and accept information.* Andrews teaches *wherein a connection is established to view, select and accept information about the offer from the first vendor where only registered with the server as authorized users are allowed to view, select and accept information* (see at least: abstract, col. 3 lines 32-40, Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Henson in view of Silva to have included *wherein a connection is established to view, select and accept information about the offer from the first vendor where only registered with the server as authorized users are allowed to view, select and accept information* as taught by Andrews in order to provide a system for automated registration, negotiation, and marketing for combining products

and services from one or more vendors together to be sold as a unit to automate the promotion and sale of product groups/bundles (see at least: Andrews, abstract, col. 1 lines 25-29).

Regarding claim 25, Henson in view of Silva teaches all of the above and further teaches *providing information from a first vendor to a second vendor about items available from the first vendor that are available for inclusion within items offered by the second vendor to a consumer for purchase at retail as a virtual bundle of items* (see at least: Henson, Fig. 3A-5; Silva, 0025-0026). Henson in view of Silva, however, does not expressly teach *wherein the server and at least one remote computer system are coupled together over the Internet to allow the user of the remote system to view, select and accept information relating to the offer.* Andrews teaches *wherein the server and at least one remote computer system are coupled together over the Internet to allow the user of the remote system to view, select and accept information relating to the offer* (see at least: abstract, col. 3 lines 32-40, Fig. 3). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Henson in view of Silva to have included *wherein the server and at least one remote computer system are coupled together over the Internet to allow the user of the remote system to view, select and accept information relating to the offer* as taught by Andrews in order to provide automate promotion and sale by combining products from multiple vendors to be sold as a group/bundle (see at least: Andrews, abstract, col. 1 lines 25-29).

6. Claims 6 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Silva as applied to claims 1-5 and 7-9 above, and further in view of Myr (US 2003/0220830).

Regarding claims 6 and 15, Henson in view of Silva teaches all of the above and further teaches communicating an offer by a second vendor to a customer for purchase (see at least: Henson, Fig. 6-10, abstract, col. 4 lines 36-52, col. 7 lines 39-48, col. 10 lines 7-18). Henson in view of Silva, however, does not expressly teach *wherein the offer by the second vendor to the consumer is communicated through in-store advertising.* Myr teaches *wherein the offer by the second vendor to the consumer is communicated through in-store advertising* (see at least: abstract, 0083). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Henson in view of Silva to have included *wherein the offer by the second vendor to the consumer is communicated through in-store advertising* as taught by Myr in order to provide a system for maximizing in-store profits by developing product bundling sets that maximize cross-selling profits (see at least: Myr, abstract, 0083).

Regarding claims 16 -18, Henson in view of Silva further teaches:

(16) *wherein the first vendor is the manufacturer of the items available for inclusion in the virtual bundle of items* (see at least: Henson, Fig. 3A-5).

(17) *wherein the second vendor and the consumer receive a financial incentive each time the consumer purchases a virtual bundle of items in a single market basket*

transaction (see at least: Henson, Fig. 3A-5, col. 4 lines 36-52, col. 6 lines 39-43, col. 7 lines 39-48, col. 10 lines 7-18). The Examiner notes that leasing options are a financial incentive.

(18) wherein information about the virtual bundle of items is posted on a server (see at least: Silva, 0025-0026, Fig. 1 and 4).

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Silva in further view of Myr, as applied to claim 15 above, and further in view of Andrews (6,285,986).

Regarding claim 19, Henson in view of Silva in further view of Myr teaches all of the above as noted and further teach *wherein information about the items available from the first vendor for inclusion in a virtual bundle is posted on a server* (see at least: Silva, 0025-0026, Fig. 1 and 4). Henson in view of Silva, however, does not expressly teach establishing an internet connection with the server *for the second vendor to view and select the items available for inclusion within the items offered to a consumer for purchase as a virtual bundle of items*. Andrews teaches an internet connection *for the second vendor to view and select the items available for inclusion within the items offered to a consumer for purchase as a virtual bundle of items* (see at least: abstract, Fig. 3-5a, col. 5 lines 1-50). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Henson in view of Silva in further view of Myr to have included *for the second vendor to view and select the items*

available for inclusion within the items offered to a consumer for purchase as a virtual bundle of items as taught by Andrews in order to provide a system for automated registration, negotiation, and marketing for combining products and services from one or more vendors together to be sold as a unit to automate the promotion and sale of product groups/bundles (see at least: Andrews, abstract, col. 1 lines 25-29).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 2002/0022970 teaches bundling travel related services
- US 2003/0149579 teaches a method of increasing functionality of a product

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Fadok can be reached on (571) 272-6755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William J. Allen
Patent Examiner
June 26, 2006